

REMARKS

This Amendment is being filed in response to a Final Office Action mailed December 22, 2006 that uses Office Action dated May 31, 2006 as a basis for rejection.

Applicants thank the Examiner for conducting an Examiner's Interview via telephone on April 18, 2007. During the Interview, Applicant Gary Solomon and his representative discussed possible amendments to claim 1 to overcome the relied upon cited art.

Claims 1-11 are pending in the application. Claim 1 is being amended. Claims 17-22 were previously withdrawn without prejudice. Claims 12-16 were previously canceled without prejudice. Claims 1-11 stand rejected. Claims 1-7 and 9 stand rejected under 35 U.S.C. 102(b) as being anticipated by Brown (U.S. Patent 5,280,661). Claim 8 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Brown. Claims 10 and 11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Wilkman (U.S. Patent 6,305,531). No new matter is being introduced by way of the amendments.

With regard to the rejection of claim 1 under 35 U.S.C. 102(b) as being anticipated by Brown, Applicants are amending claim 1 to recite that the eye wipe comprises, "a single material forming one cavity with one opening in its entirety." Support for the claim amendment is found in Applicants' specification as originally filed at least in reference to FIGS. 2A-2C.

In contrast, Brown discloses a digital wipe device that is suitable to clean eyeglass lenses. The digital wipe device includes a pair of sheaths 14, 16 each sized to hold a finger or thumb, where each sheath is configured to receive an interconnecting flexible member 24 that extends within each sheath and between the opposed open ends of the sheaths. Wiping sheets 26 are connected by stitching to the opposed sheaths along the flexible member. In other words, each cavity is formed of three materials, a sheath 14 or 16, a flexible member 24, and a wiping sheet 26 (Brown, FIG. 2). Because each of the cavities of Brown is formed of multiple materials, Brown does not disclose "a single material forming one cavity with one opening in its entirety," as recited in Applicants' amended claim 1.

The Office Action notes that it has been held "that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so

perform.” (Office Action dated May 31, 2006 at p. 3, citing *In re Hutchinson*, 69 USPQ 138) Applicant respectfully points out that Applicants’ claimed invention recites the limitation “adapted to” within a claim element in the body of the claim, while *In re Hutchinson*, by contrast, used the phrase “adapted to” as a transitional phrase in the preamble. Recent decisions by the Court of Appeals for the Federal Circuit suggest that the use of the phrase “adapted to” in the body of a claim may serve as a substantive limitation. See, e.g., *Intermatic Inc. v. Lamson & Sessions Co.*, 61 USPQ2d 1075, 1983 (Fed. Cir. 2001); *Ishida Co. Taylor*, 55 USPQ2d 1449, 1453 (Fed. Cir. 2000) (interpreting the phrase “a pair of dealing and stripping means . . . being adapted to cooperate. . .”). Moreover, the MPEP states that “[t]here is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper.” MPEP § 2173.05(g). Accordingly, Applicants submit that defining a part of their invention using the language “adapted to” is proper.

For the reasons stated above, Applicants respectfully submit that Brown is not anticipatory prior art of amended claim 1. Accordingly, Applicants respectfully request that the rejection of claim 1 under 35 U.S.C. 102(b) be withdrawn.

Claims 2-7 and 9, which depend from claim 1, should be allowable for at least the same reasons as claim 1.

With regard to the rejection of claims 8 and 16 under 35 U.S.C. 103(a), because claim 8 depends from claim 1, the arguments above apply. Thus, because claim 1 is not rejected under 35 U.S.C. 103(a), claim 8 should be allowed for at least the same reasons as claim 1. Moreover, because Brown is directed to cleaning eyeglasses having an interconnecting flexible member, sheaths 14,16, and wiping sheets 26 (col. 2, lines 34-39), Applicant’s amended claimed invention of “a single material forming one cavity with one opening in its entirety” defeats the purpose of Brown because Brown must include the flexible member, wiping sheets, and sheaths to perform the function of cleaning eyeglasses. Therefore, a prima facie case of obviousness has not been shown. Accordingly, Applicants respectfully request that the rejection of claims 8 and 16 under 35 U.S.C. 103(a) be withdrawn.

With regard to the rejection of claims 10 and 11 under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Wilkman, Applicants respectfully submit that neither Brown nor Wilkman, alone or in combination, teaches or suggests Applicants’ invention as amended in

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claim 1 as described above. In addition, Brown, as described above, fails to teach Applicants' amended claimed invention and, therefore, the combination of Brown and Wilkman also fails as a prima facie case of obviousness. Accordingly, the rejection of dependent claims 10 and 11 should be withdrawn for at least the same reasons as claim 1 from which they depend.

CONCLUSION

Any circumstance in which the Applicants have (a) addressed certain comments of the examiner does not mean that the Applicants concede other comments of the examiner, (b) made arguments for the patentability of some claims does not mean that there are not other good reasons for patentability of those claims and other claims, or (c) amended or canceled a claim does not mean that the Applicants concede any of the examiner's positions with respect to that claim or other claims.

In view of the above, it is believed that the application is in order for issuance. Should the Examiner have any further questions or comments, the Examiner is invited to call the Applicants' representative at the phone number provided below.

A Request for Continued Examination and Petition for One-Month Extension of Time are being filed concurrently herewith. The fees in the amount of \$395 for the Request for Continued Examination and \$60 for one-month extension are being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account No. 06-1050 authorization. No additional fees are believed to be due. However, the Commissioner is hereby authorized to charge any other deficiencies or required fees or any credits to deposit account 06-1050, referencing the attorney docket number shown above.

Respectfully submitted,

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